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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,349	04/15/2004	Ramin Abhari	2003B043C	8653

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EXAMINER

WYROZEBSKI LEE, KATARZYNA I

ART UNIT PAPER NUMBER

1714

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/825,349

Applicant(s)

ABHARI ET AL.

Examiner

Katarzyna Wyrozebski

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) 63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-62 and 64-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-68 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/26/06; 5/16/05; 8/10/04; 7/7/04.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 20061025.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-62 and 64-68, drawn to article and composition, classified in class 524, subclass 487.
 - II. Claim 63, drawn to process of making polymer, classified in class 525, subclass 333.7.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)).

The examiner restricted the process claims, however upon applicant's request claim 63 can be rejoined once claim 1 is considered allowable since claim 63 is dependent on composition claim 1.

3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction were not required because the

Art Unit: 1714

inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction were not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

5. During a telephone conversation with John Welch on October 25, 2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-62 and 64-68. Affirmation of this election must be made by applicant in replying to this Office action. Claim 63 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

6. Claim 20 is objected to because of the following informalities: The examiner request that the applicants clarify term "Soxhlet heptane".

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1714

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claims 61 and 62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 61 and 62 contain term "less than about", which term renders claim indefinite.

Term "less than" excludes higher amounts otherwise enabled by term "about".

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1714

10. Claims 1-62, 64-68 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-34, 58-74, 81-118 of copending Application No. 10/687,508 ('508). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

Application '508 discloses polyolefin having exactly the same properties and components as well as composition utilizing such polymer as required by the claim of the present invention. Furthermore, if applicants choose to rejoin claim 63, the double patenting rejection would also apply to the restricted claims. Therefore, if terminal disclaimer is filed then it should cover all the claims.

It would have been obvious to one having ordinary skill in the art that when practicing claims of present invention one would clearly arrive at claims of '508.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 1-62, 64-68 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-83, 103, 109-117, 137, 171-185, 206, 220, 262, 310, 348 of copending Application No. 10/686,951 ('951). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

Application '951 discloses polyolefin having the exactly same properties and components as well as composition utilizing such polymer as required by the claim of the present invention. Furthermore, if applicants choose to rejoin claim 63, the double patenting rejection would also

Art Unit: 1714

apply to the restricted claims. Therefore, if terminal disclaimer is filed then it should cover all the claims.

It would have been obvious to one having ordinary skill in the art that when practicing claims of present invention one would clearly arrive at claims of '951.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 1-62, 64-68 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-73 of copending Application No. 10/825,348 ('348). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

Application '348 discloses polyolefin having exactly the same properties and components as well as composition utilizing such polymer as required by the claim of the present invention. The composition is an adhesive composition.

It would have been obvious to one having ordinary skill in the art that when practicing claims of present invention one would clearly arrive at claims of '348.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claims 1-62, 64-68 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-44 of copending Application No.

Art Unit: 1714

10/825,635 ('635). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

Application '635 discloses polyolefin having exactly the same properties and components as well as composition utilizing such polymer as required by the claim of the present invention.

The composition is an adhesive composition.

It would have been obvious to one having ordinary skill in the art that when practicing claims of present invention one would clearly arrive at claims of '635.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1-17, 19-25, 34, 38-40, 43-54, 58, 64-68 are rejected under 35 U.S.C. 102(a) as being anticipated by KARANDINOS (US 2002/0007033).

Art Unit: 1714

KARANDINOS discloses composition for new hot melt adhesive comprising polyolefins. The properties of the polyolefins of KARANDINOS encompass the properties of the present invention. Specifically the properties include crystallinity of no more than 20% preferably no more than 15%; Tg lower than -5°C , melt index measured at 190°C of 1-2000, melt index of at least 1000. Molecular weight in examples 3 and 4 of 25000 and 28000. M_w/M_n ratio in a range of 1.5-4.

Additives include tackifiers in the amount of 1-25 wt %, flow improver of 1-20 wt %. Other additives include antioxidants, crystallinity modifiers, solvents and the like.

Although the branching index has not been reported, the polymer of KARANDINOS is made by the same process as the polymer of the present invention, which process include use of metallocene catalyst or Ziegler-Natta chemistry. In further considerations, since the properties of the polymer as well as monomeric components are the same, the branching index is expected to be an inherent property.

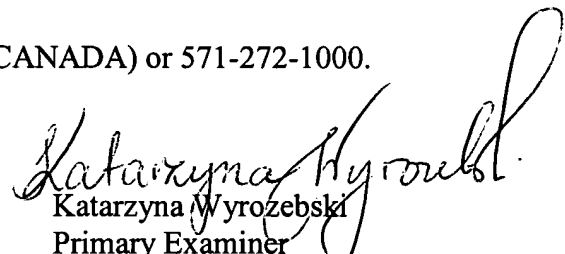
In the light of the above disclosure, the prior art of KARANDINOS anticipates claims rejected above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Katarzyna Wyrozebski
Primary Examiner
Art Unit 1714

October 26, 2006